

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/604,108 Confirmation No. 1107
Applicant : Neal A. Downey; Samuel J. Guleff; Christian C. Curtis
Filed : June 26, 2003 Art Unit: 2627
Title : MAGAZINE-BASED DATA CARTRIDGE LIBRARY
Examiner : Tianjie Chen
Docket No. : 3023726 US01
Customer No. : 67,070

ATTN: Board of Patent Appeals & Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is in response to the Examiner's Answer of September 5, 2007 which is directed to the Appeal Brief filed on May 16, 2007.

Status of the claims begins on page 2 of this paper.

Grounds of rejections to be reviewed on appeal begin on page 3 of this paper.

Reply arguments being on page 4 of this paper.

STATUS OF CLAIMS

A. Claims 1, 21-40 Are Finally Rejected

Claims 1, 21-40 stand rejected under 35 U.S.C. § 103(a) as being obvious over 5,818,723 to Dimitri (hereinafter referred to as "Dimitri") in view of U.S. Patent No. 6,324,608 to Papa et al. (hereinafter referred to as "Papa") in view of U.S. Patent No. 5,440,637 to VanFleet (hereinafter referred to as "VanFleet") and in view of U.S. Patent No. 6,532,652 to Nagai (hereinafter referred to as "Nagai"). Claim 29 stands rejected under 35 U.S.C. § 103(a) as being obvious over Dimitri in view of Papa in view of VanFleet in view of Nagai and further in view of U.S. Patent No. 6,545,865 to Albrecht et al. (hereinafter referred to as "Albrecht"). Dimitri and VanFleet and Papa and Nagai are collectively referred to as "the references."

B. Claims 1, 21-40 Are On Appeal

The decision of the Examiner finally rejecting claims 1, 21-40 is hereby appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Issues presented for consideration in this Appeal are:

- A. Whether claims 1, 21-28, 30-40 are unpatentable under 35 U.S.C. § 103 over Dimitri in view of VanFleet, Papa and Nagai for obviousness.
- B. Whether claim 29 is unpatentable under 35 U.S.C. § 103 for obviousness over Dimitri in view of VanFleet, Papa, Nagai and Albrecht.

REPLY ARGUMENTS

This reply discusses aspects of the Examiner's Answer of May 16, 2007 that Appellants believe inadequately address the arguments in the Appellants' Appeal Brief. Specifically, the Appellants believe that the applied references do not adequately provide a sufficient prima facie case of obviousness, alone or in combination, and that the Examiner's Answer avoids directly addressing this key aspect of the Appellants' arguments.

As an initial matter Appellants wish to clarify that A1-A5 in the ARGUMENT section VII of the Appeal Brief, is directed to the description of the references and not specifically to arguments presented on appeal.

With regard to Argument 1: The Examiner makes a superficially valid contention that VanFleet is a reasonable reference for use in connection with Appellants' "suitable drive means" because Appellants' description states that a drive is "capable of writing and/or reading data to/from a recording medium". However, the Examiner's contention ignores the intent of the tape cartridge library as disclosed. The quoted disclosure recitation is not limited to exclusive function (as interpreted by the Examiner), but rather, should be interpreted as activity in temporal space. For example, a host computer may require only reading data stored on a tape or later only writing data, or in some cases both reading and writing data. This line of reasoning is supported by paragraph [0092], "FIG. 5A illustrates a typical drive 180 that is employed in the magazine-based data cartridge library 100. The drive 180 is capable of writing data to and/or reading data from a recording medium that is located within a cartridge. Typically, the drive is capable of both writing data to and reading data from a recording medium located in a library." As such, Appellant believes that VanFleet is an inappropriate reference to combine with Dimitri.

With regard to Argument 2: The Examiner maintains that Papa shows a network system which includes a plurality of data storage media in a module; and "therefore, should be recognized as a library". Though Column 4, lines 1-7 of Papa indicate that different kinds of media can be used in Papa's server, one skilled in the art considers a

server to be a host computer that controls a library, and not the library itself. Considering Papa's server equivalent to a library, or even a cartridge library (a cartridge never being introduced in Papa), goes beyond the scope of Papa's disclosure of a mere server. One skilled in the art would not have been motivated to investigate, review or consider Papa for a specific element to complete the claimed invention. Hence, Papa is an inappropriate reference to combine with Dimitri and VanFleet.

With regard to Argument 3: The Examiner asserts that Papa shows conductors 421 operatively attached to the frame (Fig. 3C; column 5, lines 63-65)..." First, there is no element 421 in any of Papa's figures. Second, Papa shows a module 210 with a surface that the Examiner inappropriately compares with Appellants' frame. In order for Papa's module to be reasonably compared with Applicants' frame it should include at least the recited features of such a frame (if not the ability to support such featured elements), as recited in claim 1, namely: a shelf system, a drive means, a magazine transport, a cartridge transport device, a power supply and the conductor all operatively attached to the frame. Again, how could someone skilled in the art be expected to investigate, review and consider Papa, let alone, conclude that Papa's module plate could be used as a frame in a cartridge library? Again, Papa is an inappropriate reference to combine with Dimitri and VanFleet.

With regard to Argument 4: The Examiner maintains that Nagai "clearly show that the first tape is located between the first and second ends of Nagai's FFC" and provides images of FIGS. 3 and 5 to illustrate his position. However, the Examiner did not adequately represent the points set forth in Appellants' arguments regarding the conductor, namely, as shown in FIG. 5, the taps are at the end of Nagai's conductor (FFC). Appellant's tap provides electrical access to the flat conductor, which, as elaborated on in claim 24, can be electrically connected to a plug. Hence, element 17 of Nagai is more closely related to Appellants' tap. As is shown in FIG. 5, element 17 is (substantially) at the end of Nagai's FFC, and FIG. 3 shows how element 17 is installed at the end of the FFC. Appellants' contention that Nagai's tap is at the end of the FFC is further supported in conjunction with the textual disclosure associated with FIGS. 3 and 5

of Nagai's specification (column 4 lines 14 and 15, line 23); "Accordingly, a connection area A along the end of the FFC 11... Each connection terminal 16 has a contact 17 and a base plate 18 extending from the trailing end of the contact 17."

The Examiner has essentially tried, impermissibly, to reconstruct the claimed invention by hindsight, treating the invention as through it were a jigsaw puzzle in which one only needs to find some similarly shaped pieces of the puzzle in the prior art to reconstruct the claimed invention. However, the Examiner has illegitimately concocted the character of the prior art in an attempt to find such similarly shaped pieces where there is no true corresponding element in the prior art, or has ignored nuances of either the prior art so to force the puzzle pieces fit. Such a picture lacks integrity. There is no rationale for one of ordinary skill to search for and select elements from the disparate cited prior art in an effort to improve the technology problem being addressed to arrive at the claimed invention. The remainder of the claims stand rejected as obvious over Dimitri in view of VanFleet, Papa and Nagai and, hence, Appellant's reply adapts similar reasoning to that discussed in conjunction with claim 1, with the exception of claim 29, which stands rejected for obviousness further in view of Albrecht.

The Examiner made no mention of claim 29 in the Examiner's Answer. As elaborated on in detail in the Appeal Brief of May 16, 2007, Albrecht is misapplied because the element upon which the Examiner relied lacks true correspondence. The Examiner's silence to Albrecht is taken as a tacit acquiescence in Appellants' arguments respecting claim 29.

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Authorization To Charge Necessary Fees

The Commissioner is hereby authorized to charge any additional necessary fees associated with this submission, or credit any overpayment, to Deposit Account No. 50-3010.

Respectfully submitted,

Dated: _____

11/5/07



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